

**REMARKS**

Applicant respectfully requests reconsideration of the present application in view of the reasons that follow.

Claim 13 is currently amended without affecting the scope that claim. This amendment changes claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, is presented, with an appropriate defined status identifier.

**Claim Objections**

Claims 13, 3 and 5-8 were objected to because of certain informalities. Claim 13 is currently amended to correct the informalities noted in the office action. Therefore, Applicant respectfully requests that the objection to claims 13, 3 and 5-8 be withdrawn.

**Claim Rejections Under 35 U.S.C. § 103**

Claims 13, 3 and 5-8 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Saito et al. (U.S. Patent 5,815,772) in view of Yanagi (U.S. Patent 6,041,213). Claim 14 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Saito et al. (U.S. Patent 5,815,772) in view of Yanagi (U.S. Patent 6,041,213). Claim 15 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Saito et al. (U.S. Patent 5,815,772) in view of Yanagi (U.S. Patent 6,041,213). Claim 4 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Saito et al. (U.S. Patent 5,815,772) in view of Yanagi (U.S. Patent 6,041,213) and in further view of Tsuchitoi (U.S. Patent 5,872,900). Claims 10 and 11 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Saito et al. (U.S. Patent 5,815,772) in view of Yanagi (U.S. Patent 6,041,213) and in further view of Tsuchitoi (U.S. Patent 5,872,900).

Applicant disagrees and respectfully asserts that the Patent Office failed to establish a prima facie case of obviousness. Applicant relies on M.P.E.P. § 2143, which states that to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation in the prior art to modify the reference. Second, there must

be a reasonable expectation of success. Third, the prior art must teach or suggest all claim limitations.

Applicant respectfully submits that the references cited by the Examiner do not teach or suggest all the limitations of the claims of the present invention. Specifically, the combination of Saito et al. and Yanagi and Tsuchitoui do not describe each and every element of the claimed invention and corresponding method as recited in claims 13-15, 3-5 and 8. The claimed invention recites a pair of resist rollers (18) on a first carrying path (16) and three pairs of rollers (25a, 25b, 25c) on a second carrying path (24). (See FIG. 1) In contrast, Applicant submits that the combination of Saito et al. and Yanagi and Tsuchitoui do not teach or disclose the apparatus as claimed in the present invention. Specifically, the combination of Saito et al. and Yanagi and Tsuchitoui do not teach or disclose three roller pairs on the second carrying path and one resist roller on the first carrying path as claimed in the present invention.

First, Saito et al. teaches two pair of rollers (42, 44) and a pair of resist rollers (48), all positioned on a second carrying path (40). (See FIG. 1) However, Saito et al. does not disclose a resist roller positioned on the first carrying path with three pairs of rollers on the second carrying path. Second, Yanagi teaches a pair of resist rollers (31) on a first carrying path (25) and two pairs of rollers (19, 20) on a second carrying path (27). (See FIG. 1) Contrary to the Examiner's assertion, the combination of Saito et al. and Yanagi results in an apparatus having one resist roller on the first carrying path and a second resist roller and two pair of rollers on the second carrying path. Thus, the combination of Saito et al. and Yanagi fails to teach or disclose three pair of rollers on the second carrying path together with one resist roller on the first carrying path, as claimed in the present invention and corresponding method. In addition, Tsuchitoui fails to rectify these deficiencies in Saito et al. and Yanagi.

Furthermore, Applicant contends that there is no motivation to modify the references cited by the examiner to produce the claimed invention. Applicant relies on M.P.E.P. § 2143.01, which states that "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." In re Mills, 916 F.2d 680 (Fed Cir. 1990).

Here, Applicant respectfully submits that there is no motivation to combine Saito et al. and Yanagi. Further, Applicant contends that the combination of Saito et al. and Yanagi is not desirable or suggested by the references cited by the Examiner. The apparatus disclosed by Saito et al. consists of two pair of rollers (42, 44) and a pair of resist rollers (48) (referenced as a timing roller), all positioned on a second carrying path (40). The apparatus described by Yanagi consists of a pair of resist rollers (31) on a first carrying path (25) and two pairs of rollers (19, 20) on a second carrying path (27).

The Office Action states that Saito et al. does not disclose “a resist roller provided on the first carrying path, being located in an upstream side of the transfer device; and the object is guided in an inverted state to an upstream side of the resist roller,” but that “[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the resist roller as taught by Yanagi to the first carrying path of Saito et al...” However, Applicant asserts that since Saito et al. has a pair of resist rollers 48 on the second carrying path 40, there is no motivation to add a second resist roller 31 of Yanagi on the first carrying path. In effect, the combination of Saito et al. and Yanagi result in an apparatus with a resist roller on the first carrying path and a resist roller on the second carrying path. Having a resist roller on each path unnecessarily duplicates functionality. Thus, Applicant respectfully asserts that the references cited by the Examiner do not suggest the desirability of this combination.

Accordingly, neither reference nor the combination of Saito et al. and Yanagi and Tsuchitoi discloses all the limitations of claims 13-15, 3-5 and 8. Therefore, Applicant respectfully requests that the rejection be withdrawn. Claim 4 depends from independent claim 13 and claims 10 and 11 depend from independent claim 14 and are patentable for at least the same reason.

In summary, Applicant respectfully submits that the claims are patentable over the combination of Saito et al. and Yanagi and Tsuchitoi are therefore allowable. Therefore Applicant respectfully requests that the rejection under U.S.C. § 103(a) be withdrawn and claims 3-8, 10-11 and 13-15 be allowed.

**Conclusion**

Claims 3-8, 10-11 and 13-15 are now pending in this application. Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

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